



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

41

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/812,449

03/29/2004

Pauline Maria Foster-Hamilton

0707-00342 - G00342/US

3169

35758 7590 06/20/2007
GKN DRIVELINE NORTH AMERICA, INC
3300 UNIVERSITY DRIVE
AUBURN HILLS, MI 48326

EXAMINER

DUNWOODY, AARON M

ART UNIT	PAPER NUMBER
----------	--------------

3679

MAIL DATE	DELIVERY MODE
-----------	---------------

06/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/812,449	Applicant(s) FOSTER-HAMILTON ET AL.	
	Examiner Aaron M. Dunwoody	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-22 and 26 is/are allowed.
- 6) ☒ Claim(s) 1-11, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4878389, Boge.

In regards to claim 1, Boge discloses an improved boot comprising:

a plurality of articulating convolutes (24-26);

a grease catching member (45, 46);

a first stabilizing member (31-34) joining the plurality of articulating convolutes and the grease catching member;

a plurality of plunging convolutes(55-57); and

a second stabilizing member (41-44) joining the plurality of plunging convolutes and the grease catching member.

Note, constant velocity joint and ball spline joint assembly are not part of the claimed invention.

In regards to claim 2, Boge discloses the articulating convolutes selectively accommodate joint articulation to an angle of at least 15 degrees.

In regards to claim 3, Boge discloses the plunging convolutes selective accommodate joint plunge of at least 45 mm.

In regards to claim 4, Boge discloses the first stabilizing member is for circumscribing an inner race of the ball spline joint by about 1 mm.

In regards to claim 5, Boge discloses the second stabilizing member is for circumscribing an outer race of the ball spline joint.

In regards to claim 6, Boge discloses the constant velocity joint being a high speed fixed joint.

In regards to claim 7, Boge discloses the boot selectively accommodating vehicle installation at an angle of at least 15 degrees.

In regards to claim 8, Boge discloses the boot selectively accommodating joint operation up to approximately 7 degrees and 9000 revolutions per minute.

In regards to claim 9, Boge discloses the boot being adapted to accommodate compressive plunge of at least 15 mm and extension of 30 mm.

In regards to claim 10, Boge discloses the boot being adapted to accommodate joint plunge of at least 45 mm.

In regards to claim 11, Boge discloses the boot being comprised of a thermoplastic material.

In regards to claim 24, Boge discloses an external diameter of the grease catching member being generally greater than external diameters of either the first stabilizing member or the second stabilizing member.

In regards to claim 25, Boge discloses an external diameter of the first stabilizing member being generally less than an external diameter of either the second stabilizing member of the outer race of the ball spline joint.

Allowable Subject Matter

Claims 12-22 and 26 are allowed.

Response to Arguments

Applicant's arguments filed 4/19/2007 have been fully considered but they are not persuasive.

Applicant argues that Boge does not disclose the structural elements of claim 1. The Examiner disagrees. In regards to claim 1, Boge discloses an improved boot comprising a plurality of articulating convolutes (24-26); a grease catching member (45, 46); a first stabilizing member (31-34) joining the plurality of articulating convolutes and the grease catching member; a plurality of plunging convolutes(55-57); and a second stabilizing member (41-44) joining the plurality of plunging convolutes and the grease catching member.

Further, while anticipation requires the disclosure of each and every limitation of the claim at issue in a single prior art reference, it does not require such disclosure *in haec verba*. In re Bode, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977). In addition, it does not require that the prior art reference "teach" what the application at issue teaches. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983). Finally, Applicant is reminded that during examination claim limitations are to be given their broadest reasonable reading. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Applicant argues that Boge does not disclose the boot being adapted to accommodate compressive plunge of at least 15 mm and extension of 30 mm. The

Art Unit: 3679

Examiner disagrees. Boge discloses the boot being adapted to accommodate compressive plunge of at least 15 mm and extension of 30 mm, because it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron M. Dunwoody whose telephone number is 571-272-7080. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3679

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Aaron M Dunwoody
Primary Examiner
Art Unit 3679

.amd